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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,756	11/01/2001	Carsten Schuh	P99,0663-01	8592

7590 04/05/2005

## SCHIFF HARDIN & WAITE

Patent Department  
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EXAMINER

NGUYEN, DONGHAI D

ART UNIT

PAPER NUMBER

3729

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/003,756

Applicant(s)

SCHUH ET AL.

Examiner

Donghai D. Nguyen

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-10 and 23-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-10 and 23-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/285,917.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 07, 2005 has been entered.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3, 8-9, and 23-24 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 5,861,577 to Tamura et al.

Regarding to claim 1, Tamura et al disclose a method for producing an electrical or electronic component, the method comprising the steps of: providing a body of plastic material (3, Col. 8, lines 13-17) for accommodating and encapsulating a portion of the outer surface of the component (2), the body being a hollow body (3a) having an inside surface that is inverse in form to the outer surface of the component and an outer surface (Fig. 2), inserting the component

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into the body (Fig. 2, Col. 10, lines 2-4), and then joining the surface of the component to the body by applying pressure to the outer surface of the body of plastic material (Fig. 1 and Col. 10, lines 25-38).

Regarding claim 2, see Col. 19, lines 14-15.

Regarding claim 3, see Fig. 2.

Regarding claims 8 and 9, Tamura et al disclose the material of the body comprises a substance for mediating adhesion (Col. 8, lines 10-17) and the step of inserting the component includes inserting the component with the outer surface with a substance (Col. 19, lines 7-10).

Regarding claim 23, Tamura et al disclose a method for producing an electrical or electronic component, the method comprising the steps of: providing a component (2) with the outer surface, molding a plastic material to form a tubular body (3, Col. 10, lines 14-24) having an outside surface and a hollow space with an inside surface (3a) that is inverse in form to the outer surface of the component (2), inserting the component into the hollow space of the tubular body (Fig. 2), and then applying pressure to an outer surface of the body to join the inside surface of the hollow space to the outer surface of the component to secure the plastic coating on the outer surface of the component (Fig. 1 and Col. 10, lines 25-38).

Regarding claim 24, Figs 1-3 of Tamura et al show the step of applying pressure presses a device on the outside surface of the body to create the pressure to join the inside surface of the hollow space on the outer surface of the component.

4. Claims 1, 2, 8, 9 and 27-28 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent Re. 33,137 to Gurevich et al.

Regarding to claim 1, Gurevich et al disclose a method for producing an electrical or electronic component (15), the method comprising the steps of: providing a body of plastic material (170) for accommodating and encapsulating a portion of the outer surface of the component (15), the body being a hollow body (box-like shaped) having an inside surface that is inverse in form (rectangular box) to the outer surface of the component and an outer surface (Fig. 3), inserting the component into the body (Fig. 1), and then joining the surface of the component to the body by applying pressure to the outer surface of the body of plastic material (Fig. 2 and Col. 6, lines 58-59).

Regarding claim 2, see Col. 7, lines 37-39.

Regarding claims 8 and 9, Gurevich et al disclose the material of the body comprises a substance for mediating adhesion and the step of inserting the component includes inserting the component with the outer surface with a substance (Figs. 6-7).

Regarding claim 27, Gurevich et al disclose the outer surface of the component (15) has at least one contact lug (160) connected to an electrical terminal (20/30), and the step of joining the surface of the component to the body joins the inside surface of the body to the contact lug, a portion of the terminal and the outer surface of the component (Figs 2-3).

Regarding claim 28, Gurevich et al disclose a method for producing an electrical or electronic component, the method comprising the steps of: providing a body of plastic material (170) for accommodating and encapsulating a portion of the outer surface of the component (15), said body being a hollow body (box-like shaped) having an inside surface that is inverse in form to the outer surface of the component, the contact lug (160) and terminal (20/30), inserting the component into the body (Fig. 1), joining the surface of the component to the body by applying

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pressure to an outer surface of the body of plastic material to pressure the inside surface of the body on the contact lug, a portion of the terminal and the outer surface of the component (Figs. 2-3 and Col. 6, lines 58-59).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tamura et al or Gurevich et al.

Both Tamura and Gurevich et al do not disclose the body has at least two individual parts. It would have been an obvious matter of design choice to choose the body with any number of parts since Applicants have not disclose the specific body having at two individual parts, solves any stated problem or is for any particular reason and it appears that the invention would perform equally well with the unitary plastic body as disclosed by Tamura or Gurevich.

7. Claims 23, 24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gurevich et al.

Gurevich et al disclose a method a for producing an electrical or electronic component, the method comprising the steps of: providing a component (15) having the outer surface has

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contact lugs (160) connected to electrical terminals (20/30); molding the plastic body (170) having a outer surface and hollow space with an inside surface; insert the component into the hollow space of the body; and applying pressure to an outer surface of the body to join and secures the plastic coating on the outer surface of the contact lugs and portions of the terminals of the component in addition to the outer surface of the component (Figs. 2-3 and Col. 6, lines 58-59).

However Gurevich et al do not show the plastic body in a tubular body. It would have been an obvious matter of design choice to one having ordinary skill in the art at the invention was made to choose to mold the plastic body in any form or shape, since Applicants have not disclose the particular tubular body solves any stated problem or is for any particular reason; and it appears that the invention perform equally well with the plastic body of as taught by Gurevich et al. Further, it is well known to mold/coating the passivated body to match the designed shape of the component in the art of encapsulating an electronic component.

8. Claims 6, 7, 10, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Tamura et al or Gurevich et al in view of Applicants' Admitted Prior Art

Gurevich et al or Tamura et al disclose al the claimed invention of producing the electronic or electrical component except the body comprises at least partially cross-linked plastic and the pressure is generated by the cross-liking of the plastic of the body which is cross-linked thermally or by exposure for improving the elasticity of the silicon elastomer (See Spec page 2, line 25 to page 3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify either Gurevich et al or Tamura et al to have the body

comprising cross-link plastic by thermally or exposure as taught by Admitted Prior Art for improving the elasticity of the silicon elastomer.

### ***Response to Arguments***

9. Applicant's arguments filed January 03, 2005 have been fully considered but they are not persuasive. Applicants argue that Tamura et al do not teaching of applying pressure on the outer surface of the plastic body. The Examiner disagrees since the plastic body (3) of Tamura et al was deformed by the pressure applied on the surface of the plastic body (3) by the device/part (base metal 4) for forming a sealed structure (see Figs. 1-3)

10. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., applying radial pressure) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

11. Applicant's arguments with respect to claims 1-3, 5-10 and 23-28 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art reference US 6,008,975 teaches the method of making an electrical component having the outer surface passivated.

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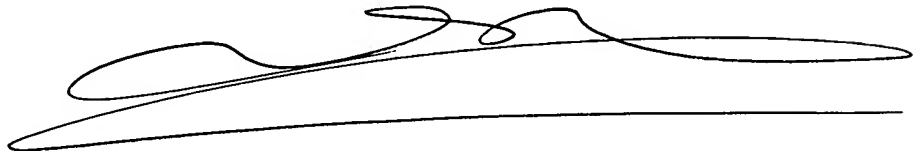
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donghai D. Nguyen whose telephone number is (571)-272-4566.

The examiner can normally be reached on Monday-Friday (9:00-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter D. Vo can be reached on (571)-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DN  
March 29, 2005

A handwritten signature in black ink, appearing to read 'PETER VO', with a long horizontal line extending to the right.

**PETER VO  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700**